

### REMARKS

This application has been reviewed in light of the Office Action dated April 20, 2006. Claims 22-33 are presented for examination, of which Claims 22, 25, 26, 29, 30 and 33 are in independent form. Claims 22, 26 and 30 have been amended to define still more clearly what Applicants regard as their invention. These changes are intended solely to clarify still further what Applicant is claiming, and do not represent a change in the intended scope of any claim. The original specification (as previously amended) has been replaced by a substitute specification submitted herewith in both marked and clean versions; no new matter has been added. Favorable reconsideration is requested.

Initially, Applicant thanks the Examiner for the allowance of Claims 25, 29 and 33.

Applicant notes that an Information Disclosure Statement and a corresponding Form PTO-1449 were filed on January 3, 2006, as evidenced by the returned receipt postcard bearing the stamp of the Patent and Trademark Office, a copy of which is attached hereto. Applicant respectfully requests the Examiner to return an initialed copy of the Form PTO-1449, indicating the references cited thereon have been considered.

Claims 22-24, 26-28 and 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Application Laid-Open No. JPA 11-17877 (Kido) in view of U.S. Patent No. 5,815,289 (Yoshida et al.).

As shown above, Applicant has amended independent Claims 22, 26 and 30 in terms that more clearly define what he regards as his invention. Applicant submits that these amended independent claims, together with the remaining claims dependent thereon, are

patentably distinct from the cited prior art for at least the following reasons.

Independent Claim 22 is directed to a facsimile apparatus for reading images of original sheets in which both-side and one-side original sheets exist mixedly and transmitting them to a receiver station. The apparatus comprises means for reading the images on both sides of the original sheet, and means for discriminating whether the images on both sides have effective image information or not. Also provided are control means adapted for selectively determining use of a both-side transmitting procedure if both sides of the original sheet have effective image information or use of a one-side transmitting procedure if both sides of the original sheet do not have effective image information, for each transmission of one original sheet, in accordance with a result of the discrimination of said discriminating means. According to Claim 22, the control means are also for transmitting to the receiver station both-side transmission control information including a page number and information regarding front or reverse side of the original sheet, for each side of the original sheet, when the both-side transmitting procedure is used, and omitting the transmission of the both-side transmission control information, so that when the one-side transmitting procedure is used, the page number is not transmitted to the receiver station, and when the both-side transmitting procedure is used, the page number is transmitted to the receiver station.

Among other notable features of the apparatus of Claim 22 is that when the one-side transmitting procedure is used, the page number is not transmitted to the receiver station, and when the both-side transmitting procedure is used, the page number is transmitted to the receiver station. By virtue of this structure, when a transmission includes both one-side original sheets and two-side original sheets, it is possible to switch appropriately between one-

side and two-side transmission procedures, and to avert the problem that would otherwise frequently occur in the form of confusion between transmitter and receiver stations as to page number, because how the page number should be treated between the transmitter and receiver stations is not defined in the ITU recommendation.

After careful further study of the prior art and the rejection, Applicant submits that the proposed combination of *Kido* and *Yoshida* is not a proper one, and that the outstanding rejection should therefore be withdrawn. For the purpose of making this analysis clearer, Applicant will repeat a portion of his previous discussion of those two documents, prior to addressing the proposed combination.

As discussed in the previous Amendments, *Kido* relates to a facsimile device that includes a first readout part that reads out one surface of an original and a second readout part that reads the other surface of an original. A first transmission data memory part temporarily stores the data read out by the first readout part, and a second transmission data memory part temporarily stores the data read out by the second readout part. *Kido* discusses deciding whether data exists on both surfaces or one surface and, if data exists on both surfaces, the original of both surfaces is simultaneously read out by two readout means and temporarily stored in each corresponding memory. If the original has data on one surface, it is read out by any of the two readout means.

Nothing has been found in *Kido* that teaches or suggests the recited control means, at the least because nothing has been found or pointed out in that document that suggests transmitting to a receiver side both-side transmission control information including a page number and information regarding front or reverse side of the original sheet, for each side of the

original sheet, when the both-side transmitting procedure is used, and omitting the transmission of the both-side transmission control information, so that the page number is not transmitted to the receiver station, when using the one-side transmitting procedure, as recited in Claim 22.

*Yoshida* relates to a facsimile apparatus for transmitting one-sided and two-sided originals. *Yoshida* discusses a both-sides original lamp that can be activated by an operator. When this is done, the operator selects a call destination, and then a display unit displays a request “SET FRONT PAGE OF THE ORIGINAL FROM THE FIRST ONE”, and the operator puts the originals on the original holder with the front pages being arranged to be read by a reading system. After a start key is pressed, the front pages of the document are read, and a counter counts the number of pages. Upon completion of reading of all the front pages of the set of two-sided originals, the display unit displays a request to “SET BACK PAGE OF THE ORIGINAL FROM THE LAST ONE”. The operator then puts the originals on the original holder with the back pages arranged to be read by the reading system, and again presses the start key. The facsimile apparatus then reads the back pages, and a counter counts the number of pages.

On the other hand, if the operator does not activate the both-sided lamp, then only the front side of each original is read, and the mentioned page-information is not obtained or sent. In either case, though, the apparatus depends on an instruction manually input by the operator, and nothing in that patent is believed to teach or suggest a means for discriminating whether the images on both sides read by a reading means have effective image information or not, as recited in Claim 22.

It should also be noted that the *Yoshida* apparatus has the operator feed the set

of originals through twice for two-sided originals, once to read the front surface of each sheet, and a second time to read the back surface. If the operator does not instruct the apparatus that two-sided originals are to be processed, then the page information cited in the Office Action as corresponding to the control information referred to in Claim 22 is not generated.

Applicant submits that a *prima facie* case of obviousness has not been made out as to Claim 22. A *prima facie* case of obviousness requires that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's own disclosure (M.P.E.P. § 2143). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In this instance, Applicant submits that the outstanding rejection fails to meet either the first or the second of these criteria.

First, it is not agreed that one of merely ordinary skill would have been motivated to attempt to combine these documents in the proposed manner. Adopting the Examiner's application of the contents of these documents to the claim language, the page number information that is generated in *Yoshida* in the two-sided mode is what should be taken

as the recited control information. It is respectfully pointed out, however, that this information is generated based on a count of read front surfaces of the two-sided originals, and on a count of the read rear surfaces. The way this is done is feeding the two-sided originals in to be read, twice, once for the front of each sheet to be read, and then again for the rear to be read. Even assuming for argument's sake that the dual reading units of *Kido* are used, the two-sided sheets must be scanned in succession, that is, without any intervening single-side documents, for the count to be accurate. Applicant submits that if the set of originals contains two separate groups of two-sided sheets, with one-sided sheet(s) separating the two groups, the *Yoshida* apparatus will count the sheets in the first two-sided group and generate page number information based on that count, and then will start over to count the sheets in the second two-sided group. That is, one of ordinary skill would not see a way using *Kido* and *Yoshida* to cause the proposed combination apparatus to generate correct page numbers for all the two-sided sheets where those sheets are not all together as a group, and thus would not have considered this combination.

Second, for this same reason, one of ordinary skill would not have considered it likely that the proposed combination would have worked, and in fact would not have had any expectation of success.

For both reasons, therefore, Applicant submits that the proposed combination is an improper one, and submits that Claim 22 is patentable over *Kido* and *Yoshida*, whether considered separately or in any permissible combination (if there is any).

Independent Claims 26 and 30 are method and storage-medium claims, respectively, corresponding to apparatus Claim 22, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 22.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other rejected claims in this application are each dependent from one or another of independent Claims 22, 26 and 30, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Leonard P Diana/  
Leonard P. Diana  
Attorney for Applicant  
Registration No.: 29,296

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

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